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WILLIAM H. BOLLMAN  
MANELLI DENISON & SELTER PLLC  
2000 M STREET, NW  
SUITE 700  
WASHINGTON, DC 20036-3307

EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/553,125

Applicant(s)

CANNON ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-2** are rejected under 35 U.S.C. 102(b) as being anticipated by Devillier (US 5,850,435).

Regarding **claim 1**, Devillier discloses a method for audible caller name announcement with call list feature (column 1, lines 8-10), (which reads on claimed “a method for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state”), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (column 2, lines 42-45), the method comprising the step of:

introducing a digitized version of the audio message (column 3, line 28 “the audible announcement”) to the called telephone apparatus (column 3, line 29 “a peripheral speaker device”) while the called telephone apparatus remains in the on-hook state (column 3, lines 28-35) [This embodiment has the advantage of not requiring the subscriber to pick up the phone to determine who is calling].

Regarding **claim 2**, Devillier discloses introducing a signal identifying the calling party during a silent interval following a first ringing signal provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 1, lines 12-20).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 3-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier in view of Brown (US 5,631,950).

Regarding **claim 3**, Devillier as applied to **claim 1** differs from **claim 3**, in that it fails to disclose a silent interval.

However, Brown teaches wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins (column 3, lines 23-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a silent interval of Brown in the invention of Devillier.

The modification of the invention would offer the capability of a silent interval such as the system would allow a calling party to enter a message to be transmitted during silent intervals of a ringing signal.

Regarding **claim 4**, Devillier discloses a method for audible caller name announcement with call list feature (column 1, lines 8-10), (which reads on claimed “a method for communicating an audio message from a calling telephone apparatus to a called telephone apparatus while the called telephone apparatus remains in an on-hook state”), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (column 2, lines 42-45), the method comprising the steps of:

converting the digitized version of the audio message to an acoustic version thereof (column 3, lines 14-20) [The IP creates, records, changes and plays the announcements]; and

introducing the acoustic version to a speaker (420 on FIG. 4) to produce an audible version of the audio message (column 3, lines 28-35) [This embodiment has the advantage of not requiring the subscriber to pick up the phone to determine who is calling].

Devillier fails to disclose receiving a digitized version of the audio message during a silent interval.

However, Brown teaches receiving a digitized version of the message during a silent interval following a ringing signal appearing at the called telephone apparatus (column 3, lines 59-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving a digitized version of the message during a silent interval of Brown in the invention of Devillier.

The modification of the invention would offer the capability of receiving a digitized version of the message during a silent interval such as the system would allow a calling party to enter a message to be transmitted during silent intervals of a ringing signal.

Regarding **claims 5, 8 and 11**, Devillier discloses receiving a signal identifying the calling party during the silent interval following a first ringing signal appearing at the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 1, lines 12-20).

Regarding **claims 6, 9 and 12**, Devillier and Brown as applied to **claim 3, 7 and 10** differ from **claim 3**, in that it fails to disclose a silent interval.

However, Brown teaches wherein the digitized version of the audio message is of sufficient duration to extend beyond the silent interval in which it begins (column 3, lines 23-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving a digitized version of the message during a silent interval of Brown in the invention.

The modification of the invention would offer the capability of receiving a digitized version of the message during a silent interval such as the system would allow a calling party to enter a message to be transmitted during silent intervals of a ringing signal.

Regarding **claim 7**, Devillier discloses a method for audible caller name announcement with call list feature (column 1, lines 8-10), (which reads on claimed "an apparatus for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state"), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (column 2, lines 42-45), comprising:

introducing a digitized version of the audio message to the called telephone apparatus (column 3, lines 28-35) [This embodiment has the advantage of not requiring the subscriber to pick up the phone to determine who is calling].

Devillier fails to disclose a silence detector and a signal injector.

However, Brown teaches a silence detector (108 on FIG. 1) detecting a silent interval following a ringing signal provided to the called telephone apparatus (column 3, lines 11-23); and

a signal injector, (120 on FIG. 1) responsive to the silence detector, introducing a digitized version of the message to the called telephone apparatus during the detected silent interval (column 3, lines 23-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a silence detector and a signal injector of Brown in the invention of Devillier.

The modification of the invention would offer the capability of a silence detector and a signal injector such as the system would allow a calling party to enter a message to be transmitted during silent intervals of a ringing signal.

Regarding **claim 10**, Devillier discloses a method for audible caller name announcement with call list feature (column 1, lines 8-10), (which reads on claimed "an apparatus for communicating an audio message from a calling telephone apparatus to a called telephone apparatus while the called telephone apparatus remains in an on-hook state"), the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (column 2, lines 42-45), comprising:

a digital-to-analog converter (407 on FIG. 4) converting the digitized version of the audio message to an audio version thereof (column 3, lines 14-20) [The IP creates, records, changes and plays the announcements]; and



a speaker (420 on FIG. 4) responsive to the audio version to produce an audible version of the audio message (column 3, lines 28-35) [This embodiment has the advantage of not requiring the subscriber to pick up the phone to determine who is calling].

Devillier fails to disclose a silence detector and a receiver responsive to the silence detector.

However, Brown teaches a silence detector (108 on FIG. 1) detecting a silent interval following a second ringing signal provided to the called telephone apparatus (column 3, lines 11-23);

a receiver (166 on FIG. 1), responsive to the silence detector, receiving a digitized version of the message at the called telephone apparatus during the detected silent interval (column 3, lines 23-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a silence detector and a receiver responsive to the silence detector of Brown in the invention of Devillier.

The modification of the invention would offer the capability of a silence detector and a receiver responsive to the silence detector such as the system would allow a calling party to enter a message to be transmitted during silent intervals of a ringing signal.

***Response to Arguments***

6. Applicant's arguments with respect to **claims 1-12** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

  
g.g.  
July 8, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

